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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,354	02/14/2005	Koichi Goto	450100-05121	6316
7590 William S Frommer Frommer Lawrence & Haug 745 Fifth Avenue New York, NY 10151				
EXAMINER KARIML PEGEMAN				
ART UNIT 2629		PAPER NUMBER		
MAIL DATE 08/04/2008		DELIVERY MODE PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/524,354

**Applicant(s)**

GOTO ET AL.

**Examiner**

PEGEMAN KARIMI

**Art Unit**

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-6 and 8-12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,2,4-6 and 8-12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed on 04/30/2008 has been entered and considered by the examiner.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4-6, and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beernink (U.S. Patent No. 5,434,929) in view of by Dolan (U.S. Patent No. 5,148,015).

**As to claims 1 and 11**, Beernink teaches an input method using an input apparatus (10) in which

a touch panel (52 and 24') is laminated onto a display screen (72) of a display apparatus (50), (col. 5, lines 61-64),

a sensor unit (72) is formed so as to be expanded to the outside of one side of said display screen (i.e. 72 includes display screen 52 and keypad 24'. Keypad 24' is arranged outside of the side screen 52), (col. 4, lines 36-39)

an instruction (pop-up window of command icon) according to a touching position of a finger or a touch pen (38) onto said sensor unit is given (col.7, lines 39-47), and

a controller (18) generates a control signal on the basis of said instruction (col. 4, lines 1-2),

comprising the steps of:

displaying a selection display (76) comprising a plurality of selection items (82) along said side of said display screen (Horizontal side of the display) when the finger or the touch pen (38) is touched to said sensor unit (col. 8, lines 49-51, and lines 58-60);

and [[instructing selection of]] selecting said [[instructed]] highlighted selection item [[when]] upon lifting the finger or the touch pen (highlighting the elements of selection items 82 by touch pen 38 and selecting a desired selection by placing the touch pen on the screen and then lifting the touch pen), (col. 8, lines 45-50) from contact with said sensor unit (placing and then lifting the touch pen from the touch screen 51) at the position of the highlighted selection item\_and (col. 9, lines 43-49), [[wherein said selection display disappears when the finger or the touch pen is moved (lifted) from said sensor unit to said display screen side]] (tapping on box 94, which is located on the display screen side, col. 9, lines 15-19), (col. 7, lines 47-50).

Beernink also teaches cancelling a selection display (quitting a session of setting preferences) when the finger or the touch pen is moved from said sensor unit to said touch panel on said display screen (by moving the stylus 38 to the touch panel on the

display screen and tapping on the close box 94 a user may quit a session of setting preferences), (col. 9, lines 15-19).

Beernink does not mention highlighting selection item as the finger or touch pen moved along said side on said sensor unit. Dolan teaches instructing one of (as can be seen in Fig. 1, when the user places his/her finger on sensor 15' the selection option 25 is highlighted) highlighting said highlighted selection items when the finger or the touch pen is near said selection items (col. 4, lines 56-63) as the finger or touch pen remains in contact with said sensor unit (as the user places his/her finger over the sensor the photo detector has activated and causes the selection to be highlighted) and is moved along said side on said sensor unit (col. 4, lines 64-67). Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the highlighting selection item by the finger or the touch pen of Dolan to the input apparatus of Beernink because The highlighting of the desired selection by the user placing his finger over a reflective sensor lined up with the displayed item will normally be sufficient to inform the user of the choice that the has elected (col. 5, lines 6-9).

**As to claims 5 and 12**, this claim differs from claim 1 only in that the limitations "a controller to which an instruction according to a touching position of a finger or touch pen onto said sensor unit is given".

Beernink teaches a controller (18) to which an instruction (pop-up window of command icon) according to a touching position of a finger or touch pen (38) onto said

sensor unit is given (col. 7, lines 39-47), (the display assembly 20 of pen-based computer system 10 is both an input and an output device and is coupled to I/O circuitry 18 by a bi-directional data bus 37, also when the buttons are selected by engaging the touch pen 38 the pressure is sensed and communicated to CPU 12 via data bus 37 and I/O 18, Fig. 1).

**As to claims 2 and 6,** Beernink teaches, operating a predetermined button (64) on a display/sensor unit of said touch panel (24') overlapped with said display screen (24' overlaps 72), an instruction corresponding to said button is generated (col. 5, lines 23-27 and col. 7, lines 39-42).

**As to claims 4 and 8,** Beernink teaches the selection display is a menu display (col. 7, lines 45-47).

**As to claim 9 and 10,** Beernink teaches a selection operation is cancelled (quitting a session setting preference) and said selection display is continued when the finger or the touch pen is moved along said sensor unit to an end area of said sensor unit out of range of said selection items on said display screen (when the pen is moved to the close box 94, which is out of range of the selection items of the display screen and is at the end of the sensor unit, the user can select the close box 94 by tapping on the close box to quit a session setting preference and continue working on the display) and thereafter lifting up the finger or touch pen from said sensor unit to said display screen side (the tapping of the close box 94 requires the user to press the pen on the close box and then lift the pen in order to select the close box 94), (col. 9, lines 15-19).

***Response to Arguments***

4. Applicant's arguments filed 04/30/2008 have been fully considered but they are not persuasive.

Applicant argues that the prior art does not show, teach or suggest the invention wherein cancelling a selection display when the finger or touch pen is moved from the sensor unit to the touch panel on the display screen. Examiner finds the term "finger or touch pen is moved" very broad and can be interpreted as "lifting and moving". Beernink teaches wherein a close box 94 that allows a user to quit a session of setting preferences by simply selecting "tapping" on the close box. The user moves from the screen 72 to the display screen 52, which is the location outside of 24' and tapping the close box 94 on the screen.

Applicant argues that tapping a close box 94 closes the window 72, the close tap closes setting preferences (i.e. 76, which is character style preference).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Inquiry***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGEMAN KARIMI whose telephone number is (571)270-1712. The examiner can normally be reached on Monday-Thursday 8:00am - 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegeman Karimi/

/Chanh Nguyen/



Art Unit: 2629

Examiner, Art Unit 2629  
July 31, 2008

Supervisory Patent Examiner, Art  
Unit 2629